

**REMARKS**

Claims 1-38 were originally presented. Claims 16-38 are withdrawn from consideration. Claims 1-15 are currently pending for examination.<sup>1</sup> Claims 1-15 have been rejected. Claims 1, 7 and 8 have been amended. Support for the amendment to claim 1 can be found at page 9, lines 21-22 and in original claim 7. No new matter has been added as a result of the amendment.

**RESPONSE TO REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH**

The Examiner has rejected the pending claims under 35 U.S.C. §112 for lack of enablement. Applicants respectfully disagree with Examiner's statements as follows:

"The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." *United States v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988). The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498, 504 (CCPA 1976). As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied. *In re Fisher*, 427 F.2d 833, 839 (CCPA 1970). Failure to disclose other methods by which the claimed invention may be made does not render a claim invalid under 35 U.S.C. 112. *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1533 (Fed. Cir. 1987).

Applicants disagree with the Examiner's conclusion that the claims are not enabled. Applicants have provided detailed exemplary embodiments using vitamin E TPGS and Al Tri-Sec-Butoxide. According to the Examiner, Applicants "demonstrate efficacy with the above cited compounds." The fact that Applicants have not demonstrated efficacy with other compounds hardly means that the claims lack enablement and indeed is not the appropriate standard for determining the existence enablement under Federal Circuit precedent. According to the Examiner's reasoning, Applicants would have to demonstrate efficacy with each and every

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<sup>1</sup> In the office action, the Examiner has incorrectly stated that claims 11-38 are withdrawn from consideration and claims 1-10 are pending. In the Response to Restriction Requirement filed on August 16, 2004, Applicants elected

compound that are likely to fall within the scope of claim in order for the claims to be enabled. However, this demonstration is not required for a finding of enablement. Applicants have provided sufficient details in the Specification via Working Examples, which would enable one having reasonable skill in the art to practice the claimed invention without undue experimentation. The fact that a skilled artisan may need to engage in some experimentation does not make it undue.

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). The Examiner's explanation that Applicants have not demonstrated efficacy of the use of compounds other than vitamin E TPGS and Al Tri-Sec-Butoxide does not provide the requisite "reasonable basis" for a finding of non-enablement. The details provided by Applicant in the Specification would enable one having reasonable skill in the art to practice the invention with an acceptable amount of experimentation.

#### **RESPONSE TO REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH**

The pending claims are rejected under 35 USC § 112, second paragraph. The Examiner states that term "aging" is vague for failure to specify a time limit. Without acquiescing to the propriety of the rejection and in an effort to further prosecution, Applicants have amended claim 1 to specify a time limit.

The pending claims are also rejected under 35 USC § 112, second paragraph for failing to specify amounts or ratios of ingredients. The claims are directed to method steps which do not require limitations directed to amounts and ratios of ingredients used in the method. The breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689 (CCPA 1971). The scope of the claimed invention which is directed to the recitation of a method for the preparation of a mesoporous composition having a series of discrete steps, is not governed specific ratios and amounts of ingredients, but rather by the specific steps employed. Therefore,

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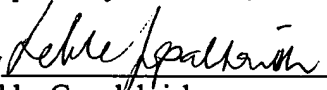
claims 1-15 in Group I with traverse. Therefore, it is Applicants' position that claims 1-15 are currently pending in the present action.

it is Applicant's belief that specifying amounts or ratios of ingredients is not necessary in the context of the claimed method.

No fees are believed to be due in connection with this paper as this response is being timely filed. However, if any fees are due in connection with this filing, the Commissioner is authorized to charge Deposit Account No. 10-0447 (Ref. No. 46847-00007USPT) for the required amount.

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Respectfully submitted,

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